REMARKS

In a non-final Office Action dated August 6, 2009, the Examiner in charge of the application withdrew the finality of her previous Office Action in response to Applicants' request for continued Examination and made a restriction requirement final. The Examiner incorrectly stated the status of the claims; Claim 6 and 8-11 are withdrawn from consideration, Claims 1-5 and 12-13 are cancelled, and Claim 7 is pending and under consideration. The Examiner withdrew her rejections for alleged lack of written description and enablement as well as her rejection for alleged anticipation. The Examiner maintained her provisional rejection for alleged obviousness-type double patenting and rejection for alleged obviousness, each of which is discussed in turn below.

Provisional rejections for obviousness-type double patenting

Certain claims of co-pending US Application No. 11/195,561 are now allowed. However, Claim 48, cited by the Examiner here as the basis for a provisional double-patenting rejection, is cancelled. Accordingly, this provisional rejection cannot mature into an actual rejection for obviousness-type double patenting and should be withdrawn.

Rejections under 35 U.S.C. § 103

The only other maintained rejection is for alleged obviousness of Claim 7 over Crooke at al. in view of Monia et al. Applicants traverse this rejection because the combination of Crooke and Monia would not bring the skilled artisan to the invention. A skilled person reading Crooke's use of antisense to modulate SCD1 would not have found it obvious to recognize the effect of decreased SCD1 activity on insulin sensitivity, and Crooke would have had no basis to assume any connection between the two. Indeed, the Examiner acknowledged that Crooke did not teach measuring insulin sensitivity.

The Examiner has given inadequate weight to the affirmative recitations in the claim of measuring and observing. The skilled artisan would not have undertaken the recited steps because the art at the time of filing appreciated no link between insulin sensitivity and SCD1 modulation. Monia is not to the contrary, and does not fill the acknowledged gap between Crooke and the pending claim. Monia provides the skilled artisan with no reason to measure insulin sensitivity in conjunction with modulating SCD1. As Applicants have already argued,

Monia's result obtained by modulating expression of the PTEN gene with an antisense oligonucleotide is not in and of itself surprising, but it bears little relation to Applicants' interference with SCD1 activity. SCD1 is not believed to be involved in the insulin signaling pathway, but rather is believed to be a gene involved in insulin metabolism. A skilled artisan reading Crooke and Monia would have concluded only that one can modulate SCD1 activity and that one can increase insulin sensitivity by inhibiting expression of PTEN.

The Examiner's reliance on use of an antisense oligonucleotide complementary to PTEN, a gene unrelated to SCD1 and associated with a distinct pathway, is misplaced in regard to the claimed method. In fact, Monia would lead a skilled person away from increasing insulin sensitivity by modulating SCD1, and instead toward an unrelated method: increasing insulin sensitivity by modulating translation of the distinct gene in the distinct insulin signaling pathway. Monia's indication that insulin sensitivity can be measured after modulating the activity of a distinct gene only highlights the fact that Monia provides no basis from which the skilled artisan would even consider measuring insulin sensitivity after modulating SCD1. The citations relied upon by the Examiner are at cross-purposes and neither disclosure is particularly pertinent to the other.

The Examiner's asserted basis for finding *prima facie* obviousness is flawed. In particular, the Examiner glosses over and provides no support for the alleged link between the two citations. The Examiner's position asserts no scientific basis (apart from idle curiosity, and absent hindsight in view of Applicants' present disclosure) for any motivation to measure insulin sensitivity in connection with SCD1 modulation. The mere coincidence that both citations mention using antisense oligonucleotides as general diagnostic tools can surely not rise to the level of adequate disclosure to render obvious the claimed invention. Reconsideration is respectfully requested.

Fees

An extension of time of three months is believed due. A Petition for the appropriate extension of time accompanies this response so the response will be deemed to have been timely filed. If any extension is due in this or any subsequent response, please consider this to be a petition for the appropriate extension and a request to charge the petition fee due to Deposit

Account No. 17-0055. No other fee is believed due, but if any other fee is due in this or any subsequent response, please consider this to be a request to charge the fee to the same Deposit Account.

Respectfully submitted,

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